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EXAMINER				
STRODER, CARRIE A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/563,188

Applicant(s)

HARKIN, WILLIAM JAMES

Examiner

CARRIE A. STRODER

Art Unit

3689

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-17 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-17 and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the applicant's communication filed on 23 December 2010, wherein:

Claims 15-17 and 19-22 are currently pending;

claims 15, 19-20, and 22 are currently amended; and

claims 1-14, 18, and 23-46 are cancelled.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 15-22 are rejected** under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 15 and 22 invoke 35 USC 112, sixth paragraph, when stating, "input means for". However, the specification does not describe adequate structure for performing the recited function.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 15-21 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15 states that it is a system which includes a "data storage means," a "data processing means," an "input means for..." an "output means for...", and a "means for real time communication." A system claim is defined by structure. However, neither a "data storage means," nor a "data processing means," provide structure. As such, these claim limitations receive little patentable weight. However, in order to expedite prosecution, Examiner attempts to give weight to these limitations for purposes of the prior art rejections, below.

The claim limitations of claim 15 which are directed to an "input means for...", an "output means for...", and a "means for real time communication..." are interpreted in accordance with 35 USC 112, sixth paragraph, as providing structure. However, when Examiner turns to the specification, no structure is provided for these limitations. If there is no disclosure of structure,

material or acts for performing the recited function, the claim fails to satisfy the requirements of 35 U.S.C. 112, second paragraph. MPEP 2181.

Claim 17 states that it is a system which includes a "data processing means," an "input means". A system claim is defined by structure. However, neither a "data processing means," nor "input means" provide structure. As such, these claim limitations receive little patentable weight. However, in order to expedite prosecution, Examiner attempts to give weight to these limitations for purposes of the prior art rejections, below.

Claim 19 states that it is a system which includes a "non-real time communication means". A system claim is defined by structure. However, a "non-real time communication means" does not provide structure. As such, this claim limitation receives little patentable weight. However, in order to expedite prosecution, Examiner attempts to give weight to these limitations for purposes of the prior art rejections, below.

Claim 20 states that it is a system which includes an "access regulation means". A system claim is defined by structure. However, an "access regulation means" does not provide structure. As such, this claim limitation receives little patentable weight. However, in order to expedite

prosecution, Examiner attempts to give weight to these limitations for purposes of the prior art rejections, below.

5. **Claim 22 is rejected under 35 U.S.C. 112, second paragraph,** as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 22 states that it is a system which includes a "data storage means," a "data processing means," an "input means for..." and an "output means for..." An apparatus or system claim is defined by structure. However, neither a "data storage means," nor a "data processing means," provide structure. As such, these claim limitations receive little patentable weight. However, in order to expedite prosecution, Examiner attempts to give weight to these limitations for purposes of the prior art rejections, below.

The claim limitations of claim 22 which are directed to an "input means for..." and an "output means for..." are interpreted in accordance with 35 USC 112, sixth paragraph, as providing structure. However, when Examiner turns to the specification, no structure is provided for these limitations. If there is no disclosure of structure, material or acts for performing the recited function, the claim fails to satisfy the requirements of 35 U.S.C. 112, second paragraph. MPEP 2181.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. **Claims 15-17 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grainger et al. (US 20020059076), in view of Fredell et al. (US 6678698).**

Referring to claim 15:

Grainger discloses

data storage means including data structures representing templates for documents for use in commercialization of intellectual property rights (paragraphs 90-100; "...storage system..." and "...patent application template...");

data processing means in communication with the data storage means, for retrieving and manipulating the data structures (paragraph 85; "client computer");

input means for inputting data and commands to the data processing means (paragraph 54; "user input device"); and

output means for outputting manipulated data structures from the data processing means (paragraph 85; where "client computer" is interpreted to include a monitor or display device).

Further, "for use in commercialization of intellectual property rights," and "for retrieving and manipulating the data structures" are directed to intended use and as such, receive little patentable weight.

Grainger discloses a system for facilitating the process of preparing and filing patent applications. Grainger does not disclose means for real time communication between data processing means, said means for real time communication being selected from the group consisting of video-conferencing and text-based messaging; wherein the data processing means allows multiple users to access and amend the data structures in a single session.

However, Fredell teaches a similar system for communicating and managing project information. Fredell teaches

means for real time communication between data processing means, said means for real time communication being selected from the group consisting of video-conferencing and text-based messaging (col. 11, lines 3-25; "video conferencing");

wherein the data processing means allows multiple users to access and amend the data structures in a single session (col. 11, lines 3-25; "A lead entity can set up connections with associated entities for white boarding and for *real time collaborative annotation of documents*." and further, "allows multiple users to access and amend the data structures in a single session" is an optional claim limitation and as such, receives little patentable weight and also, Examiner notes that this limitation does not modify the structure of the system and therefore, receives little patentable weight).

It would have been obvious for a person of ordinary skill in the art (PHOSITA) at the time of invention to modify the system disclosed in Grainger to incorporate means for real time communication between data processing means, said means for real time communication being selected from the group consisting of video-conferencing and text-based messaging; wherein the data processing means allows multiple users to access and amend the data structures in a single session as taught by Fredell because this would provide a manner for collaborative and instantaneous communication and editing, thus aiding the client by providing a more efficient means of completing a project when those involved in the project are unable to meet face to face.

Referring to claim 16:

Grainger discloses wherein the output means comprises a remote communications link to one or more further data processing means (paragraph 44; "...computers 103 and automated docketing server 108 are networked together via a private network 132. The private network 132 is coupled to the Internet 101, for example, via a router. The Internet 101 interconnects the private network 132 to a patent office 112 and to a smart filing server 107.").

Referring to claim 17:

Grainger discloses wherein a plurality of data processing means and input means are provided (paragraphs 44 & 54; "computers" and "User input device 230 may include a mouse, a trackball, a keyboard, a keypad, a touch pad, a joystick, a digitizing tablet, a wireless controller, a microphone, or other suitable input devices, or combinations thereof.").

Referring to claim 19:

Grainger discloses non-real time communication means, selected from the group consisting of email and webmail facilities (paragraph 66; "The mail server 324 provides functionality to send electronic mail...").

Referring to claim 20:

Grainger discloses access regulation means selected from the group consisting of system privileges and = password protection (paragraph 126; "Such access should be restricted (by way of passwords or otherwise) to only particular users.").

Referring to claim 21:

Grainger discloses wherein the data structures are selected from one or more of: project plans, invention disclosure forms, license agreements, business plans, contracts for outside suppliers, and the like (paragraph 92; "...an interactive smart disclosure form...").

Referring to claim 22:

Grainger discloses
data storage means including data structures representing templates for documents for use in management of a project (paragraphs 90-100; "...storage system..." and "...patent application template...");

data processing means in communication with the data storage means, for retrieving and manipulating the data structures (paragraph 85; "client computer");

input means for inputting data and commands to the data processing means (paragraph 54; "user input device"); and

output means for outputting manipulated data structures from the data processing means (paragraph 85; where "client computer" is interpreted to include a monitor or display device).

Further, "for use in management of a project," and "for retrieving and manipulating the data structures" are directed to intended use and as such, receive little patentable weight.

Response to Arguments

Applicant's arguments regarding the rejection under 35 USC 112 filed 23 December 2010, have been fully considered but they are not persuasive. Applicant argues that the claims comply with 35 USC 112. Examiner respectfully disagrees.

With regard to "data storage means": applicant argues that page 10, lines 25-27 provides structure for the data storage means. However, "data storage means" does not invoke 112, sixth paragraph. Examiner cannot read limitations from the specification into the claims. Further, the specification states, "the output means may comprise a data storage device..." as there is an output means referred to later in claim 15, it would not seem that the "data storage means" being referred to in claim 15 is the data storage device in the specification.

With regard to "data processing means": applicant argues that specification, on page 24, lines 28-30 describes a

processor, which applicant states is the structure for the "data processing means." Again, "data processing means" does not invoke 112, paragraph six. Examiner cannot read limitations from the specification into the claims. Further, the processor is not clearly described as being the "data processing means" of claim 15.

With regard to "input means for": this limitation does invoke 112, paragraph six. However, the applicant must still comply with 112, second paragraph. Applicant states that the "input means for" corresponds to structure described in the specification on page 24, lines 30-32. However, when Examiner turns to this section, it states, "The processor 14 includes a data input device 16, such as a keyboard and mouse..." The data input device is not clearly linked to the "input means for" limitation of claim 15. Examiner cannot be certain that this is what should be referred to as the "input means for". Further, the use of the language "such as" is indefinite. It is not clear that the structure being referred to is limited to a keyboard and mouse. Persons who are attempting to determine if they might infringe this claim cannot be certain of the metes and bounds. What other input devices might the applicant bring in to the claim? It is limitless, leaving other persons unable to determine if they may be infringing the claim.

With regard to "output means for": this limitation does invoke 112, sixth paragraph. Therefore, Examiner turns to the specification to determine the structure being referred to by this limitation. The specification, on page 10, lines 23-30 states, "The output means may comprise a hard copy output device, such as a printer, plotter, or the like; or the output means may comprise a data storage device, such as a disc drive, tape drive, hard drive, CD-writer, or similar device. Preferably however the output means comprises a remote communications link to one or more further data processing means" (emphasis added). Applicant must still comply with 112, second paragraph when invoking 112, sixth paragraph. The potential infringer must be able to read the specification and determine what is being referred to as an "output means for." However, applicant has included so many indefinite terms, that Examiner is unable to determine the metes and bounds of the claim, and neither would any potential infringer be able to determine such.

With regard to "means for real time communication": this limitation does invoke 112, sixth paragraph. Applicant refers Examiner to page 11, lines 4-9, which state in part, "The system may further comprise means for real time communication between data processing means; for example, videoconferencing, internet

telephony, text-based messaging, or the like" (emphasis added). Applicant must still comply with 112, second paragraph when invoking 112, sixth paragraph. The potential infringer must be able to read the specification and determine what is being referred to as a "means for real time communication." However, applicant has included so many indefinite terms, that Examiner is unable to determine the metes and bounds of the claim, and neither would any potential infringer be able to determine such. For example, would making a telephone call on a regular telephone be included? Examiner does not know.

With regard to "non-real time communication means": this limitation does not invoke 112, sixth paragraph. Examiner may not read limitations from the specification into the claim. No structure is provided and it is unclear what structure could be provided. E-mail and web-mail are not structures. A processor might be programmed to send e-mail or web-mail, but other structures could also be involved. Examiner cannot determine the metes and bounds of the claim.

With regard to "access regulation means": this limitation does not invoke 112, sixth paragraph. Examiner may not read limitations from the specification into the claim. No structure is provided and it is unclear what structure could be provided. System privileges and password protection are not structures,

such as would be expected in a system claim. Examiner cannot determine the metes and bounds of the claim.

Examiner notes that applicant does not address the rejections under 35 USC 103 at all. This is non-responsive to Examiner's rejection. However, in an effort to move prosecution forward, and recognizing that applicant amended claim 15 substantially, upon which most of the uncanceled claims depend, Examiner has provided this response. Examiner must assume, based on the amendments, that applicant acquiesced in the rejection previously provided. However, claim 22 was not substantially amended in such a way as to negate Examiner's prior art rejection. Examiner can only assume that applicant also acquiesces to the rejection previously provided.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action

is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 8:00 a.m. - 5:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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